

## REMARKS

Claims 1-41, 43, 45, 47 and 49 are pending in the application.

### ***Claim Rejections under 35 U.S.C. § 112***

On pages 4-5 of the Action, the Office has rejected claims 42, 44, 46 and 48 under 35 USC §112 as failing to comply with the written description requirement as containing subject matter which was not described in the specification. Claims 42, 44, 46 and 48 are hereby canceled.

On page 5 of the Action, the Office has rejected claims 43, 45, 47 and 49 under 35 USC §112 as failing to comply with the written description requirement as containing subject matter which was not described in the specification. The Office has stated that the added limitation “wherein the display apparatus permits the utilization of other computer functions on at least one underlying screen of the overlay window” is new matter. The applicant respectfully directs the Office to page 14, lines 14-18 of the specification which disclose:

“The analog video signal is converted to digital video data which may then be displayed in an overlay window on screen 216 using VGA. In this manner, a user may receive and view the audiovisual content **while also using the computer for other purposes or while viewing other information in computer graphics mode**” (emphasis added).

One skilled in the art would recognize that use of an “overlaying” window on a display necessarily implies the existence of display elements “underlying” the overlay window. The cited disclosure clearly contemplates using the remainder of the display not covered by the overlay window (i.e. the display regions “underlying the overlay”) for “other purposes” or viewing “other information.” One skilled in the art would recognize a myriad of other obvious functions which could be performed or “information” which could be displayed in this underlying area. As such, the Applicant respectfully requests that the rejection of claims 43, 45, 47 and 49 under 35 USC §112 be removed.

***Claim Rejections under 35 U.S.C. § 103***

On page 4 of the Action, the Office has rejected claims 1-3, 8, 9, 14, 15, 24, 25 and 28 under 35 U.S.C. § 103(a) as being unpatentable over U.S. Patent No. 6,046,721 (Song) in view of U.S. Patent No. 6,567,097 (Iwaki), U.S. Patent Application Publication No. 2003/0128970 (Lan), U.S. Patent Application Publication No. 2002/0126141 (Mastronardi) and U.S. Patent No. 6,417,867 (Hallberg).

The Office has rejected claims 4-7, 16-19, 31-34 and 37-39 under 35 U.S.C. § 103(a) as being unpatentable over Song in view of Iwaki, Lan, and U.S. Patent No. 5,850,340 (York).

To establish *prima facie* obviousness of a claimed invention, all the claim limitations must be taught or suggested by the prior art. *In re Ryoka*, 180 U.S.P.Q. 580 (C.C.P.A. 1974). See also *In re Wilson*, 165 U.S.P.Q. 494 (C.C.P.A. 1970). Also, “in order to render a claimed apparatus or method obvious, the prior art must enable one skilled in the art to make and use the apparatus or method.” *Rockwell Int'l Corp. v. United States*, 147 F. 3d 1358, 47 U.S.P.Q.2d 1027, 1032 (Fed. Cir. 1998) (citing *Motorola, Inc. v. Interdigital Tech. Corp.*, 121 F. 3d 1461, 1471, 43 U.S.P.Q.2d 1481, 1489 (Fed. Cir. 1997)). Therefore, “a reference published before a patent’s critical date is prior art only for that which the reference enables.” *F.B. Leopold Co. v. Roberts Filter Mfg. Co.*, Civ. App. 96-1218 (Fed. Cir. July 2, 1997) (unpublished) (citing *Beckman Instruments, Inc. v. LKB Produkter AB*, 892 F.2d 1547, 1551, 13 U.S.P.Q.2d 1301, 1304 (Fed. Cir. 1989)).

The Office has rejected independent Claims 1 and 14 as unpatentable over Song in view of Mastronardi and Hallberg. As stated by the Office, “Song does not disclose the communication channel for transmitting commands and information to and from said host computer system and to and from said display apparatus.” Mastronardi and Hallberg are cited for teaching “a communication channel for transmitting

commands and information to and from a host computer system and to and from a display apparatus."

Mastronardi discloses a touch-screen interface module where a user presses his/her finger against the screen to transfer controls/information to the computer from the display. Hallberg discloses a video adapter driver program which can be used to toggle between various display modes. The Office asserts that "it would have been obvious to one skilled in the art at the time of the invention to modify Song's system by incorporating a touch-screen monitor that allows users to select which mode the user desired through a user interface program where a user selects the desired mode, a command is sent to the computer from the touch-screen monitor and a command is sent from the computer to the display to change the mode of the display."

Applicant respectfully submits that the combination of Song with Mastronardi and Hallberg with respect to the transfer of commands and information to and from the display and the host computer is improper.

The mere fact that the prior art may be modified in the manner suggested by the Examiner does not make the modification obvious unless the prior art suggested the desirability of the modification... It is impermissible to use the claimed invention as an instruction manual or 'template' to piece together the teachings of the prior art so that the claimed invention is rendered obvious. This court has previously stated that "one cannot use hindsight reconstruction to pick and choose among isolated disclosures in the prior art to deprecate the claimed invention." *In re Oetiker*, 977 F.2d 1443, 24 USPQ 2d 1443 (Fed. Cir. 1992) quoting *In re Fine*, 837 F.2d 1071, 1075 USPQ 2d 1596, 1600 (Fed. Cir. 1988).

Song specifically discloses two keyboard-type switches connected directly to a multi-functional monitor so as to provide the required control mechanism for the switching of the monitor between modes (see FIG. 2A, references 18 and 19). The display of Song changes based on the state of these switches and the frequency and polarity of the input signals to achieve an accurate PAL, NTSC or VGA mode (col. 9, lines 50-54) and not on any control command issued by a computer.

To modify Song by Mastronardi and Hallberg would necessarily destroy the desired functionality of Song as a multi-function monitor that combines television and computer display circuits which merely uses a computer to analyze and adjust a television signal or a computer signal for display on a dual purpose monitor based upon the nature of the input signal. The combination of Mastronardi, Hallberg and Song would result in a device having superfluous computer control on top of the existing simplified keyboard control mechanisms of Song, thereby introducing an unnecessary level of complexity *in opposition* to the teachings of Song.

As such a limitation regarding “a communication channel for transmitting commands and information to and from a host computer system and to and from a display apparatus” clearly distinguishes the independent claims of the present invention over Song in view of Mastronardi and Hallberg.

The Office has also rejected claims 4-6 and 16-18 as unpatentable over Song in view of York. As presented in the Appeal Brief filed during the prosecution of U.S. Patent Application No. 09/954,889, (now U.S. Patent No. 6,7234,351), of which the present case is a continuation-in-part, Song fails to teach control in response to commands from a host computer system (emphasis added). Song teaches configuration of a monitor based solely on the nature (i.e. interlaced or non-interlaced) of an incoming input signal. In Song, a program determines whether the monitor is in “computer” or “television” mode (col. 10, lines 11-23) by testing the frequency and polarity of horizontal and vertical sync signals (col. 9, lines 57-59). Song does not provide for host computer control of a television (see FIG. 1). The signal of Song is not disclosed as containing or being coded with instructional information other than the display and synchronization signals. In fact, Song is wholly silent with regard to any control of the television other than switching between a television mode and a computer mode.

York is cited for its teaching of the control of a display apparatus in response to computer commands. However, Applicant respectfully submits that a combination of Song and York is improper as no motivation for such a combination exists.

As previously noted, Song specifically discloses a keyboard connected directly to a multi-functional monitor so as to provide the required control mechanism for the switching of the monitor between modes (see FIG. 2A, references 18 and 19). Song only uses the computer to route a given display signal to the screen.

To modify Song by York would necessarily destroy the desired functionality of Song as a multi-function monitor that combines television and computer display circuits which merely uses a computer to analyze and adjust a television signal or a computer signal for display on a dual-purpose monitor based upon the nature of the input signal. The combination of York and Song would result in a device having superfluous computer control on top of the existing simplified keyboard control mechanisms of Song, thereby introducing an unnecessary level of complexity *in opposition to* the teachings of Song.

Claims 1 and 14 have been amended to include the limitation that the microprocessor element of the invention "receives at least one command from said host computer system, the command suitable for controlling a television function of the display apparatus from the host computer system." The current versions of Claims 31 and 37 contain similar limitations. Such a limitation clearly distinguishes the independent claims of the present invention over Song in view of York.

Applicants respectfully submit that none of the other cited references cure the defects of Mastronardi, Hallberg and York with respect to Song. Therefore Claims 1, 14, 31 and 37 are allowable.

Claims 2-13, 15-30, 32-36, 38-41, 41, 43, 45, 47 and 49 are believed to be allowable based on their dependence upon allowable base claims.

**CONCLUSIONS**

In light of the forgoing, reconsideration and allowance of the claims is earnestly solicited.

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